

REMARKS

Claims 57-60 have been additionally cancelled, without prejudice.

Claims 1-6, 9-10, 12-13, 19-21, 25, 27-30, 32-33, 36-39, 41, 42, 44, 4, 61 and 63-64 have been (additionally) amended. All amendments are fully supported, no new material has been introduced.

Accordingly, claims 1-30, 32-39, 41-48, 51-54, and 61-64 are now pending.

Claim Rejections Under 35 U.S.C. §112

In the subject Final Office Action, claims 1-2, 5-6, 9, 12-13, 19, 25, 27-29, 32, 37-39, 41, 44, 46, 57-59 and 61 were rejected under 35 U.S.C. §112 second paragraph. Rejections against claims 57-59 have been rendered moot by their cancellations. Where appropriate, claims 1-2, 5-6, 9, 12-13, 19, 25, 27-29, 32, 37-39, 41, 44, 46, and 61 have been amended, overcoming the Examiner's objections. Accordingly, withdrawal of the objections is respectfully requested.

Claim Rejections Under 35 U.S.C. §101

In the subject Final Office Action, claims 1, 19-20, 32, 38, 41 and 58 were rejected under 35 U.S.C. §101. Rejection against claim 58 has been rendered moot by its cancellation. Claims 1, 19-20, 32, 38 and 41 have been amended, overcoming the Examiner's rejections. Accordingly, withdrawal of the rejections is respectfully requested.

Claim Rejections Under 35 U.S.C. §102

In the subject Final Office Action, claims 1-2, 5-14, 16-21, 24-30, 33, 36-39, 41-42, 45-48, 51-54, 57-58 and 61-62 were rejected under 35 U.S.C. §102(e) as being anticipated by US patent no. 6,151,643 issued to Cheng et al. (herein after "Cheng"). Rejections against claims 38 and 57-58 have been rendered moot by their cancellations. Claims 1-2, 5-14, 19-21, 25, 27-30, (32), 33, 36-39, 41-42, 46, 61 and 63 have been amended.

For at least the reasons set forth below, claims 1-2, 5-14, 16-21, 24-30, 33, 36-37, 39, 41-42, 45-48, 51-54, and 61-62 are patentable over Cheng.

Claim 1 (as amended) recites a computing device implemented method of selecting software components for installation on a client computer. The method comprises:

receiving from the client computing device, a request for upgrade of a first software component capable of being processed by the client computing device;

receiving configuration information regarding a software configuration of the client computing device including information regarding at least one additional software component that is necessary for execution of the first software component and that the at least one additional software component has been determined to be missing from the client computing device;

identifying second software components for installation on the client computing device based at least in part upon the request and the configuration information, the second one or more software components including but not limited to the update for the first software component the at least one necessary additional software component determined to be missing from the client computing device; and

transmitting the second one or more software components to the client computing device

Thus, a client computer makes a request for an upgraded software component. Configuration information is received from the client computer including information regarding at least one additional software component that (a) is necessary for the execution of the software component that is to be upgraded by the client computer, and (b) has been determined to be missing from the client computer. Based at least in part upon this configuration information (having necessary but missing components for the requested upgraded), software components are identified for installation on the client computer, and are transmitted to the client computer. These software components include but are not limited to the upgrade of the first software component and the missing components. In other words, the identified and transmitted software components include software components beyond the upgrades and the missing components reported (see e.g. page 14, lines 26-29 of present specification). Applicant respectfully submits that the recited “receive” and “identify” operations are not taught or suggested by Cheng.

In rejecting claim 1, the Examiner asserted that the “identified” operation is anticipated by Cheng’s teachings on col. 3, lines 1-24. The subject message merely states that

“ ... The software update information in the database specifies the software update program or files and their network location ... The database further stores information that describes an installation process for installing the software update on a user’s computer ... In addition, the software update information includes a format description associated with specific installation programs or actions needed to install the software update.”

It is well settled that 102 rejections require clear and explicit anticipation in the cited reference. Applicant submits the vague reference to “actions needed to install the software update” does not explicitly anticipate the recitation of “identifying second software components for installation on the client computing device based at least in

part upon the request and the configuration information, the second one or more software components including but not limited to the update for the first software component the at least one necessary additional software component determined to be missing from the client computing device".

Accordingly, for at least the foregoing reason, claim 1 is patentable over Cheng.

Independent claims 13, 19, 20, 32, 39, 41 and 61 have been amended to include in substance the limitation discussed earlier with respect to claim 1. Thus, for at least the same reasons, claims 13, 19, 20, 32, 39, 41 and 61 are also patentable over Cheng.

Claims 2, 5-12, 14, 16-18, 20-21, 24-30, 33, 36-37, 42, 45-48, 51-54, and 61-62 depend on either claim 1, 13, 19, 20, 32, 39, 41 and 61, incorporating their recitations respectively. Thus, for at least the same reasons, claims 2, 5-12, 14, 16-18, 20-21, 24-30, 33, 36-38, 42, 45-48, 51-54, and 61-62 are patentable over Cheng.

Claim Rejections Under 35 U.S.C. §103

Claims 3, 4, 15, 25, 22-23, 31, 34-35, and 43-44

Claims 3, 4, 15, 25, 22-23, 31, 34-35, and 43-44, were rejected as being obvious in view of Cheng and Official Notice taken by the Examiner re "determining expiration time and stopping the identification step".

The Examiner's official notice, even if correct, does not remedy the above discussed deficiency of Cheng, i.e., Cheng's failure to teach or suggest the recited "receive" and "identify" operations involving "software components (that) include but are not limited to the upgrade of the first software component and the missing

components.” Therefore, independent claims 1, 13, 19, 20, 39, 41 and 61 remain patentable over Cheng even when combined with the Examiner’s Official Notice.

Claims 3, 4, 15, 25, 22-23, 34-35, and 43-44 depend on either independent claim 1, 13, 20 and 41, incorporating their recitations respective. Thus, for at least the same reasons claims 3, 4, 15, 25, 22-23, 34-35, and 43-44 are patentable over Cheng in combination with the Examiner’s Official Notice.

Further, Applicant traverses the Official Notice taken by the Examiner. Again, Applicant respectfully reminds Examiner that MPEP §2144.03 states that “Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” MPEP §2144.03 continues to state, “it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to ‘fill in the gaps’ which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.”

The use of a file creation date and time may be well-known in the art. However, the use of an expiration time in association with a configuration file (as recited in claim 3), and moreover, the use of an expiration time to stop identification of one of more components upon expiration of the configuration file (as recited in claim 4) is not known. Applicant once again submits that such functionality is not notoriously well-known in the

prior art, and formally requests the Examiner to provide the evidence to support the Examiner's assertion that the subject matter is well known in the art, if the Examiner continues to maintain the rejections on the asserted ground.

Claims 59-60 and 63-64

Claims 59-60 and 63-64 were rejected in view of Cheng and Kenner.

Rejections against claims 59-60 and 64 have been rendered moot by their cancellations.

With respect to claim 64, Kenner does not remedy the above discussed deficiency of Cheng, i.e., Cheng's failure to teach or suggest the recited "receive" and "identify" operations involving "software components (that) include but are not limited to the upgrade of the first software component and the missing components." Therefore claim 61 remains patentable over Cheng even when combined with Kenner.

Claim 64 depends on claim 61 including its recitations, therefore, for at least the same reasons, claim 64 is patentable over the cited references.


Conclusion

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability

without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections and early issuance of the Notice of Allowance are specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: October 13, 2005



Al AuYeung
Registration No. 35,432

Pacwest Center, Suites 1600-1900
1211 SW Fifth Avenue
Portland, Oregon 97204
Telephone: 503-222-9981